



Docket Code: AP.PRE.REQ

PTO/SB/33 (07/05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LOTA101

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on MARCH 10, 2006

Signature *A. Mullins*

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Application Number

10/660,402

Filed

09/10/2003

First Named Inventor

LOTT, ERIC G.

Art Unit

3635

Examiner

HORTON

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number 46,260

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MARCH 10, 2006

Date

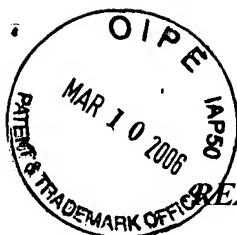
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR THE PRE-APPEAL BRIEF REQUEST FOR REVIEW

The present invention, as claimed, is novel and non-obvious, as discussed below.

General Discussion

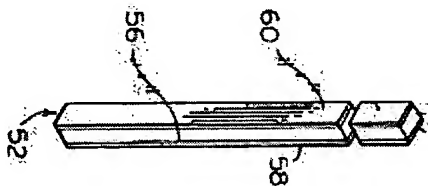
A major point of contention between the Applicant and the Examiner is the definition of what a "stud" is. Applicant intends that it is clear that the invented engineered lumber stud is a replacement for a traditional structural dimensional lumber stud (see [0004]-[0005]). Thus, the present invention is a structural piece; a vertical support piece of a wall unit that supports the wall and materials attached thereto (i.e., drywall, etc.). Dictionary definitions of the term "stud" define the term as "*an upright post in the framework of a wall for supporting sheets of lath, wallboard, or similar material.*"¹ This is the definition someone skilled in the art would use.

Whereas, the Examiner appears to be of the opinion that any and all walls, wall panels, wall structures, etc. are "studs."

Claim Rejections - 35 USC § 102

1. Claims 1, 3, and 4 stand rejected under §102(b) as being anticipated by Taraba, et al., U.S. Patent No. 5,701,708. This reference was first cited in the Second Office Action (6/27/2005). Claim 17 also stands rejected under §102(b) as being anticipated by Taraba. This rejection was first made in the Third Office Action (1/13/2006).

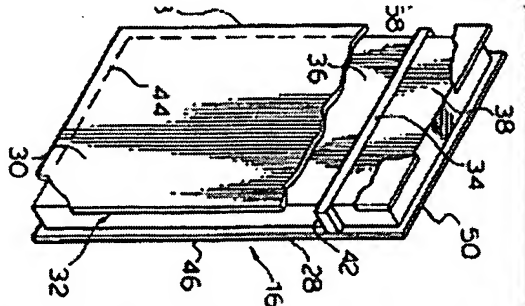
a. The Examiner, in initially citing Taraba, pointed out that Taraba anticipates because it shows "*engineered lumber stud (figure 2) comprising a first skin piece (58) positioned generally parallel to a second skin piece (60)...*" Such structure is essentially this:



b. The Applicant amended claim 1 to include the limitations that the stud have a pair of ends and at least one of these ends defines a channel for receiving either a top plate or a bottom plate therein. Taraba does not show such a structure and therefore does not anticipate.

¹ "stud." The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. *Answers.com* 03 Mar. 2006. <http://www.answers.com/topic/stud>

c. In the Third (Final) Office Action, the Examiner changed her story, now pointing out that Taraba anticipated because it discloses “an engineered lumber stud (figure 2) comprising a first skin piece (28)...second skin piece (30)...channel (as at 32)...” Such structure is generally this:



d. Applicant disagrees that Taraba anticipates because Taraba fails to show all of the elements of the claims. Further, Taraba (as most recently cited by the Examiner) does not show a “stud,” but instead shows a “building panel (16)” and the channel (32) cited by the Examiner is not even in the first or second end of the panel, but is in the side of the panel.

e. Regarding claim 17, the same arguments apply. Taraba does not show an engineered lumber stud having first and second skin pieces sandwiching a piece of foam there-between, the stud having a first end and a second end, with a channel in either the first or second end for receiving a spacer.

2. Claim 1, 10 and 11 stand rejected under §102(b) as being anticipated by Henley, et al., U.S. Patent No. 4,852,310. This reference was first cited in the Second Office Action.

a. In that Action, regarding claim 1, the Examiner argued that Henley shows “an engineered lumber stud (figure 24)...first skin piece (63)...second skin piece (65)...channel defined by the first skin piece and the second skin piece and the foam core (where 16 points to); the channel configured to receive at least one top (at 54) and bottom (at 90) plate or spacer (at 71).” Regarding claims 10 and 11, the Examiner argued that Henley “discloses a wall panel (figure 24) comprising a plurality of generally spatially positioned, generally parallel lumber studs (at 63 and 69); each of the studs define a first and second channel...(at 61 where 90 lies)...”

b. Claim 1 (as amended) includes the limitations that stud has a pair of ends and at least one of these ends defines a channel for receiving either a top plate or a bottom plate therein. Henley does not show such a structure. Henley shows generally C-shaped end caps for framing in doorways and other structures in walls. For this reason, Henley does not anticipate the present invention in claim 1.

- c. As for claims 10-11, Applicant respectfully disagrees that Henley shows a wall panel comprised of a plurality of engineered lumber studs with top and bottom plates.
- 1) The “studs” referred to by the Examiner are not even studs. They are end caps for the lower portions (74) of the posts (62).
 - 2) The “studs” referred to by the Examiner are not used to comprise a wall panel in conjunction with top/bottom plates.
 - 3) For those reasons, Henley, et al., does not anticipate the present invention in claims 10-11.
3. Claims 13-16 stand rejected under §102(b) as being anticipated by Aizawa, U.S. Patent No. 4,044,182. This rejection first surfaced in the Second Office Action.
- a. The Examiner argues that “*Aizawa discloses the claimed invention ... comprising the steps of creating a panel body (A), making a plurality of cuts through first and second skins.*” The Examiner fails to include the claim 13 element of “...to create a plurality of generally parallelepiped engineered lumber studs” in her analysis altogether.
 - b. Aizawa does not disclose making a plurality of cuts through first and second skins to create engineered lumber studs. Aizawa’s cuts are just slits...they do not even go through the pieces.
 - c. Aizawa discloses taking strips of green veneer, cutting a slit in the strips and inserting a string in the slit, and then bonding piles of such strips together to make a veneer core block for plywood. A stud or any similar structure is not made in the process. Citation of this reference is odd because no “generally parallelepiped engineered lumber studs” or anything even remotely resembling a “stud” is created. For that reason, it is Applicant’s position that Aizawa does not anticipate the present invention in claims 13-16.

Claim Rejections - 35 USC § 103

1. The Examiner rejected claim 2 under §103(a) as being unpatentable (obvious) over Taraba, et al., in view of Petersen, U.S. Patent No. 4,224,774.
- a. As discussed above, Taraba, et al., does not anticipate claim 1 because claim 1 has been amended to include the limitations that the stud has a pair of ends and at least one of these ends defines a channel for receiving either a top plate or a bottom plate therein, limitations that Taraba does not show. Petersen does not show these limitations either.
 - b. Without Taraba, et al., nor Petersen showing all elements/limitations, a prima facie case has not been met. For this reason, the present invention is not obvious over Taraba, et al., in view of Petersen.

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2. The Examiner rejected claim 5 under §103(a) as being unpatentable (obvious) over Taraba, et al., in view of Henley, et al., U.S. Patent No. 4,852,310.

a. Claim 5 depends from claim 1. Taraba, et al., does not anticipate claim 1 because claim 1 has been amended to include the limitations that stud has a pair of ends and at least one of these ends defines (as discussed in claims 8 and/or 9) a channel for receiving either a top plate or a bottom plate therein. A thorough discussion of why Taraba does not anticipate can be found *supra*.

b. As for Henley, et al.:

- 1) The “studs” referred to by the Examiner are not even studs. They are end caps for the lower portions (74) of the posts (62); and
- 2) The “studs” referred to by the Examiner are not used to comprise a wall panel in conjunction with top/bottom plates.

c. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art).

d. The language of the claims clearly patentably distinguishes the present invention over the prior art as combined. The prior art, as combined do not show an “engineered lumber stud.” These claims clearly define that the present invention (in those claims) is an engineered lumber stud. In the application, it is clear that the invented engineered lumber stud is a replacement for a traditional, structural, dimensional lumber stud (see [0004]-[0005]). Thus, it is clear that the present invention is a structural piece; a vertical support piece of a wall unit that supports the wall and materials attached thereto (i.e., SheetRock, etc.).

e. The closest thing in Taraba to a “stud” is what is referred to as a “connector stud” (52). This connector stud is not a “stud” in the traditional sense, but is “stud shaped” (depth greater than width ala “2x4”). This connector stud is not a structural piece, but is an interconnector used to connect two adjacent building panels (16) together. The Taraba, et al., connector stud is no more a stud than a wood joint biscuit is.

f. Henley, et al., on the other hand, shows a filler panel (69), which is used as an end cap for a wall for creating door or window spaces. The Henley, et al., filler panel (69) is likewise not a stud in the traditional sense. It is not structural, but more a filler piece for framing in a door or window space.

g. The Examiner argues that the combination of this interconnector of Taraba and the end cap of Henley, renders the present invention (an engineered structural lumber stud) obvious. Applicant disagrees. Neither of the two prior art references shows an engineered structural lumber stud. Thus, it seems illogical that combining the teachings of the two references together would arrive at an engineered structural lumber stud, let alone that there would be motivation to do so.

h. The Examiner has not shown nor proved any motivation exists in the references themselves to modify the prior art. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”), see also *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998) (“the Board must identify specifically...the reasons one or ordinary skill in the art would have been motivated to select the references and combine them”). Further, the case law is clear that the Examiner must produce objective evidence of a motivation to modify the prior art. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added). No such evidence was provided by the Examiner.

i. The Applicant further argues that what the Examiner is doing is hindsight reconstruction. There is no suggestion or motivation to combine the selected elements of the prior art references. The only possible incentive to make such a combination would be through hindsight reconstruction using the Applicant’s specification. Such action is improper. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed.Cir. 1992).

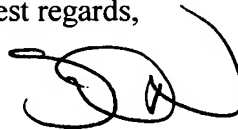
j. For these reasons, Applicant disagrees that the present invention, as defined in claim 5, is obvious over Taraba, et al., in view of Henley, et al.

Conclusion

As such, Applicant believes that the invention as claimed is both novel and nonobvious. Reconsideration and allowance is respectfully requested.

DATED this 10th day of March 2006.

Best regards,



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